REMARKS:

This communication is in response to the detailed office action dated April 26, 2004. The Applicants wish to thank the Examiner for finding the subject matter of claim 8 to be allowable.

In the office action, the Examiner rejected claims 1-3, 5-7, and 10-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,947,238 to Jolly *et al.* (hereinafter "Jolly") in view of U.S. Patent No. 6,471,018 to Gordaninejad *et al.* (hereinafter "Gordaninejad"). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Jolly in view of U.S. Patent No. 5,120,030 to Lin *et al.* (hereinafter "Lin"). Claims 10-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jolly in view of Gordaninejad and further in view of U.S. Patent No. 5,301,974 to Knapp (hereinafter "Knapp"). Furthermore, the Examiner rejected claims 1, 3, and 5-7 under 35 U.S.C. § 103(a) as being unpatentable over Gordaninejad. The Examiner failed to specifically reference the status of claim 4 as being rejected, and if so, under which grounds and upon which art, or whether claim 4 contains allowable subject matter.

The rejections are respectfully traversed. In rejecting claims 1-3, 5-7, and 10-12 the Examiner states that Jolly discloses, in figure 6a, a shock absorber having a piston 26f and a magnetic field generating unit (32f 32f', 32f'') mounted on an interior side of the cylinder 22f but lacks discussion related to what type of material the internal side of the cylinder is formed from. *See* Office Action dated April 26, 2004, pg. 2. The Examiner turns to Gordaninejad for disclosing the use of either ferrous or non-ferrous materials for the cover/housing 1,16. *Id.* The Examiner also states, in rejecting claims 1, 3, and 5-7 that Gordaninejad discloses, in column 8 and figure 7, all the features required except for the specifics of the metallic materials from which the cylinder and/or piston is made. *Id.* at pg. 4. However, the Applicants believe the Examiner has overlooked a feature claimed in the present application that is not found in the prior art made of record and, therefore, the cited prior art does not teach or suggest each claim element rendering the rejections improper.

In greater detail, Jolly discloses a damping device utilizing magnetically controllable fluid. *See* Jolly, col. 1, ll. 7-15. The damping device has a housing 22a with an internal cavity 24a receiving a piston 26a. *Id.* at col. 2, ll. 32-37. The piston subdivides the internal cavity into first and second chambers. *Id.* Passageways 36a interconnect the first chamber and the second chamber and allow magnetorheological fluid 34a contained within the first

and second chambers to pass therebetween. *Id.* at col. 2, ll. 41-49. At least one magnet 32a is included that produces a magnetic flux which is directed through the magnetorheological fluid contained within a passageway. *Id.* at col. 2, ll. 56-63. Critically different from the present application, Jolly discloses a magnet with NORTH and SOUTH POLES and the corresponding magnetic flux emanating therefrom being ALIGNED WITH THE LONGITUDINAL AXIS of the device. *Id.* at col. 9, ll. 14-16; col. 11, ll. 3-5, and FIGS.

In contrast, the above-identified application claims a device including components that are not disclosed or suggested in Jolly. The present application claims magnets disposed in the device with NORTH and SOUTH POLES and the corresponding magnetic flux emanating therefrom in a RADIAL OR PERPENDICULAR DIRECTION TO THE LONGITUDINAL AXIS of the cylinder and piston complex. *See* Present Application, claims 1, 8, and 13, paragraph [008], [0028], and FIG. 2. In this case, when the piston moves upward and downward, the magnetic flux incident on the metallic coating of the external surface of the piston changes, creating eddy currents and heat in the metallic coating, thereby ultimately reducing the translational speed of the piston. *Id.* Jolly does not disclose or suggest the placement of magnets such that the magnetic flux emanates perpendicular to the longitudinal axis of the dampening device. To the contrary, the magnets disclosed in Jolly are positioned such that their magnetic flux emanates in the longitudinal direction of the damping device. *See* Jolly, FIGS. 1a-12a, 12c, col. 11, ll. 3-6.

The Examiner relies on Gordaninejad, Lin, and Knapp for disclosing other missing elements and limitation of Jolly to arrive at the claimed invention in the present application. *See* Office Action dated April 26, 2004. However, Knapp does not disclose any type of magnets utilized in their device, thus, combining Knapp with Jolly does not remedy the missing elements claimed in the present invention. Moreover, the disclosures of both Lin and Gordaninejad fail to teach the use of radial magnets in which the North and South poles and corresponding magnetic flux emanating therefrom are oriented perpendicular to the longitudinal direction of the damping device. Similar to Jolly, Gordaninejad discloses a magneto-rheological fluid disposed in a cavity with a magnet disposed to produce a magnetic field within the cavity whereby the magnetic flux emanates parallel to the longitudinal axis and motion of the piston. *See* Gordaninejad, Abstract, FIGS. 3, and col. 3, ll. 23-26. Meanwhile, Lin discloses the use of magnetic material facing each other with similar poles oriented to repel the closing of the damping device. *See* Lin, Abstract, FIGS. 4 and 5

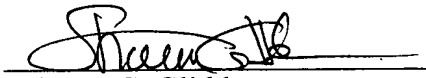
Therefore, Gordaninejad, Lin, and Knapp fail to disclose the claimed limitation of RADIAL MAGNETIC ORIENTATION and thereby fail to remedy the lacking elements of Jolly. As a result the Applicants respectfully request the rejection of the claims be removed and the claims allowed.

The Applicants have amended claim 1 to more clearly recite the limitation of the magnetic flux being oriented in the radial direction, substantially perpendicular to the longitudinal axis of the cylinder. Claim 8 has been amended to the independent form, including each limitation of the claim from which it originally depended and each intervening claim. Furthermore, the Applicants have added new claim 13. No new matter has been added with these amendments.

In view of the foregoing remarks and amendments, it is believed that the application as a whole is in form for allowance. Should the Examiner have any continuing objections or concerns, the Examiner is respectfully asked to contact the undersigned at 415-442-1106 in order to expedite allowance of this case. Authorization is granted to charge any outstanding fees due at this time for the continued prosecution of this matter to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (matter no. 060944-0164).

Respectfully submitted,

Date July 26, 2004



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